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08/689,721 08/12/96 PERRY

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EXAMINER

MMC2/1121

GREGORY T. KAVOUNAS
MARGER JOHNSON & MCCOLLOM, P.C.
1030 S.W. MORRISON STREET
PORTLAND OR 97205

LUEBKE, R
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 44

Application Number: 08/689721
Filing Date: August 12, 1996
Appellants: Andrew M. Perry

Gregory T. Kavounas
For Appellant

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EXAMINER'S ANSWER

This is in response to appellant's original brief on appeal filed May 5, 2000 and the supplemental appeal brief filed September 12, 2000.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the original brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the original brief.

(3) Status of Claims

The statement of the status of the claims contained in the original brief is correct. In summary, claims 11-13 are pending and this appeal involves only claims 11 and 12. Appellant has offered to cancel claim 13 if claims 11 and 12 are "found patentable as presently pending."

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the original brief is correct.

(6) Issues

The appellant's statement of the issues in the supplemental brief is incorrect and the statement in the original brief was made incomplete by the Office action subsequent thereto. As detailed below, based on the three grounds of rejection there are three issues:

- 1.) the objection to the amendment under 35 U.S.C. 132,
- 2.) the rejection under 35 U.S.C. 112 due to lack of possession by the inventor, and
- 3.) the rejection under 35 U.S.C. 112 due to lack of enablement.

(7) Grouping of Claims

Appellant's briefs each include a statement that claims 11 and 12 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the original brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The amendment filed October 12, 1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure.

Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pulling the recorder apart and then placing the ring thereon, does not reasonably provide enablement for performing this operation *after* the strap has been placed on the neck of the user.

(11) Response to Arguments

35 U.S.C. 132

The amendment filed October 12, 1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no "amendment shall introduce new matter into the disclosure of the invention." The added material which is not supported by the original disclosure is the order of the method steps that requires the strap to be placed on the neck of the user and *then* requires the recorder to be pulled apart and placed in the ring.

Appellant argues that it is improper to reject claims as new matter under 35 U.S.C. 132. However, the claims have not been *rejected* under 35 U.S.C. 132. The examiner has *objected* to the amendment. (The claims are rejected under 35 U.S.C. 112 as indicated above and further discussed below.) 35 U.S.C. 132 states that no new matter may be added to the **disclosure**

of the invention. The claims are part of the disclosure of the invention and therefore new matter is not permitted therein. It is noted that 35 U.S.C. 132 generally discusses both rejections and objections to any claim and to other parts of the application. It is unclear why appellant believes that only the last sentence of the section refers specifically to the specification, but not to a claim.

Appellant quotes MPEP 2163.06 in support of the argument that new matter in the claims should be rejected under 35 U.S.C. 112. Appellant is correct that this rejection should be and has been made. However, this section does not state that an objection under 35 U.S.C. 132 should not also be made. Contrary to appellant's conclusion, the objection to the amendment as new matter does not misapply the MPEP.

35 U.S.C. 112, first paragraph - possession of the claimed invention

Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The original specification did not suggest that the ring be placed on the recorder *after* the strap was placed around the neck of the user. There is no indication that this specific method was known or contemplated by the inventor, nor that he considered this method to be his invention.

Appellant has not argued this rejection in either brief.

35 U.S.C. 112, first paragraph - enablement

Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pulling the recorder apart and then placing the ring thereon, does not reasonably provide enablement for performing this operation *after* the strap has been placed

on the neck of the user. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to perform the method of the invention commensurate in scope with this claim. The order of the assembly is critical and essential to the practice of the invention since it is included in the claims; however, it is not enabled by the disclosure.

Appellant appears to object to the manner in which this rejection has been made. Although this is not sufficient to rebut the substance of the rejection, it is noted that the examiner *has* followed the guidelines (not requirements, as suggested by appellant) of the MPEP. As quoted from both of the previous two rejections, the specification, “does not reasonably provide enablement for performing this operation *after* the strap has been placed on the neck of the user.” Clearly this information is needed because it is the basis for the claims and one cannot claim material or steps that were not disclosed in the original application.

In regard to the substance of the rejection, appellant’s arguments generally allege that the specification is sufficient to show one how to perform the required steps, at least without undue experimentation. It may be true that, given the apparatus shown in the originally filed application, one skilled in the art (admittedly not a high level of skill) could come up with all of the possible ways to maneuver the parts, thereby meeting the claimed steps. However, finding all of the possible permutations of the steps *is* seen to be undue experimentation. Questions of enablement “are evaluated against the claimed subject matter.” (MPEP 2164.08) The claims are very specific to the method, a method that is not specifically taught in the original specification.

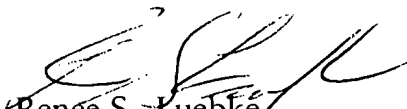
Appellant states that the examiner “must concede that at least one of these sequences has been enabled” (original brief, page 7, lines 19-20). Yes, one of the sequences is enabled. As noted in the last Office action, the specification is enabling for pulling the recorder apart and then


placing the ring thereon, but does not reasonably provide enablement for performing this operation *after* the strap has been placed on the neck of the user. But, the claimed sequence is not mentioned in the specification. Appellant also states that the claimed sequence of steps is enabled "at least implicitly" from the disclosure. However, claimed limitations cannot be implied. The claimed subject matter must be present in the specification. Similarly, appellant state that the particularly claimed scenario "was not explicitly mentioned, because it did not need to be" (original brief, page 8, lines 3-4). Again, appellant is improperly basing the enablement of the claim on what one would have to assume from the specification. The claimed subject matter must be present, not assumed, in the original application.

If the originally presented specification had been a patent, could the present claims have been rejected under 35 U.S.C. 102 in view thereof? This examiner thinks not. If there is not enough information in the specification to support a rejection of a claim, there is not enough to support enablement of the claim.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Renee S. Luebke
Primary Patent Examiner
November 14, 2000

Appeal Conference Conferee:
Paula Bradley 

Gregory T. Kavounas
Marger Johnson & McCollom, P.C.
1030 S.W. Morrison Street
Portland, Oregon 97205